



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

#13
L05
7-30-03

In re Application of:

David LIU et al.

Application No.: 09/329,209

Group Art Unit: 2142

Filed: June 10, 1999

Examiner: Harrell, R.

Attorney Docket: 09710-1146

Client Docket: CAR-99-006

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Technology Center 2100

For: NETWORK APPARATUSES, NETWORKS, COMPUTER PROGRAM PRODUCTS,
AND MANAGEMENT STATION OPERATIONAL METHODS

REPLY BRIEF

Honorable Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This Reply Brief is submitted, in triplicate, in response to the Examiner's Answer mailed
May 19, 2003.

I. EXECUTIVE SUMMARY

The Examiner continues to misconstrue the claimed invention, and contorts the teachings of *Kracht* (US 6,377,987) in an effort to support his rejection, particularly with respect to the feature of "transmitting subsequent commands that are different from the prior commands." It has been Appellants' consistent position that this claimed feature differs from the disclosure of *Kracht*; namely, *Kracht*'s second attempt at identification does not entail issuance of a second (or subsequent) command (Appeal Brief, page 8, paragraph 2). The Examiner erroneously asserts

that the *Kracht* system's discovery mechanism for retrieval of "additional configuration information" as requiring the invocation of the claimed subsequent command to identify the devices. First, the *Kracht* system issues only one command to try to identify a device in a network, and if that fails, *Kracht* does not issue a subsequent command to the same device in a further attempt at identification. Second, the discovery mechanism to which the Examiner refers is not attempting to obtain additional identifying information, but "configuration information" from KNOWN devices; the configuration information merely provide such information as Internet Protocol (IP) and Medium Access Control (MAC) addresses of the interfaces of the device (col. 10, lines 20-23 of *Kracht*). Third, the discovery mechanism of *Kracht* for gathering "configuration information" is a process completely independent from how the *Kracht* system identifies a particular device, and thus, a request for the configuration information cannot constitute a "subsequent command" in the manner claimed.

For these and the reasons that follow, Appellants respectfully request the Honorable Board to reverse the Examiner's rejection.

II. THE EXAMINER CONTINUES TO MISINTERPRET *KRACHT*, WHICH FAILS TO DISCLOSE TRANSMITTING SUBSEQUENT COMMANDS THAT ARE DIFFERENT FROM THE PRIOR COMMANDS.

The Examiner's reliance on the discovery mechanism for obtaining "configuration information" as requiring the use of the claimed "subsequent commands" is in error. This faulty interpretation is misguided in several ways: the Examiner misunderstands how the *Kracht* system identifies device types; the Examiner confuses the very different processes of device identification and gathering of configuration information; and the Examiner does not appreciate that "configuration information" does not provide identification of the device.

It is unequivocal that the *Kracht* system operations are divided into the following distinct processes: “IDENTIFYING DEVICE TYPES” (col. 7, line 27 – col. 8, line 59); and “GATHERING INFORMATION THAT IS SPECIFIC TO THE TYPE OF KNOWN DEVICE” (col. 10, lines 17-55). To identify a device, the *Kracht* system does not require use of a subsequent (or second) command, but instead bases a second attempt at identification of the device on the received sysObjectID using its prefix, the MIB sysServices value to identify the service layers, and the bit vector 300 (see FIG. 3).

In search of a possible candidate for the claimed “subsequent command” the Examiner turns to an entirely different process – the process of “GATHERING INFORMATION THAT IS SPECIFIC TO THE TYPE OF KNOWN DEVICE” (col. 10, line 17-18). Specifically, the Examiner (on page 7 of the Examiner’s Answer) refers to the passage of col. 10, lines 19-21, which states “the discovery mechanism requests additional configuration information that is specific to each type of each known device. In particular, the specific configuration information identifies what IP and MAC addresses are seen on what interfaces of each known device.” This cited passage pertains to the gathering of additional “configuration information”; therefore, such a request is not in fact a “subsequent command” in the context of identifying the device, as the device is presumed to be “known” at this point in the operation of *Kracht*.

Further, the cited passage clearly indicates that “configuration information identifies what IP and MAC addresses are seen on what interfaces of each known device.” Appellants submit that this configuration information does not identify the device, but merely the addresses of the device’s interfaces. The Examiner would surely acknowledge that different devices (e.g., router models) can possess interfaces that can be assigned with addresses without identifying the devices (e.g., vendor and model).

It is evident that *Kracht* fails to disclose the claimed features, and that the Examiner's misinterpretation of *Kracht* is necessary to maintain the Examiner's ground of rejection.

III. THE EXAMINER HAS NOW PROVIDED FOR THE FIRST TIME THE BASES FOR HIS REJECTION OF CLAIMS 15, 19, 21, 23, AND 23.

The Examiner now explains his rationale for the rejection of claims 15, 23, and 33, referring to the FIGs. 7 and 8 of *Kracht*. In the Examiner's Answer (pages 8 -9), the Examiner's periodic references to the rejection of claim 13 as stated in the Final Office Action is uninformative, as the Final Office Action merely states "per claims 13 and 14, see col. 7 (lines 35- et. Seq.) 'MIB'."

Now, the Examiner argues (Examiner's Answer, page 8) that "such information inherently was stored for latter recall," and tersely "That's inherent." (Examiner's Answer, page 9) Claims 15, 23, and 33 recite "an asset table." Such language conveys the manner in which the information is stored, not simply that the information can be stored. The Examiner plainly ignores the language of "table." There is no inherency, as it is known that information can be stored in any number of ways. The Examiner is merely putting forth the possibility that the information displayed in the user interface windows (shown in FIGs. 7 and 8) of *Kracht* can be stored as a table. However, inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Roberstson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). In the case at hand, the Examiner conveniently draws the conclusion, based on possibilities, that the *Kracht* system employs a table structure to store information for display in the user interface windows.

The explanations for the rejection of claims 19 and 21 are similarly unenlightening. (Examiner's Answer, page 9) The Examiner contends that "Examiner need not specifically point

to a figure that jumps out at the Appellant.” 35 U.S.C. § 132 may not go as far as requiring explanation that “jumps out,” but it does require more than a blanket assertion that “per the other claims not specifically mentioned, they too are rejected for the reasons outline above.” (Final Office Action, page 2) It is well settled in law that the Examiner is obliged to identify wherein an applied reference discloses features relied upon to deny patentability to a claimed invention. *In re Rijckaert*, 9 F. 3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

IV. THE EXAMINER’S “RARE FINDING”

Appellants acknowledge that the Examiner’s “rare finding” is not a rejection.

V. THE EXAMINER HAS COMMITTED A PROCEDURAL DUE PROCESS VIOLATION.

The Examiner now attempts, in the Examiner’s Answer, to introduce three new references, Google (McCollum), SATAN, and *Tonelli et al.* (U.S. Pat. No. 5,821,937), under the guise of stating the general art of Network Discovery, without imposing a new ground of rejection. This constitutes a violation of due process of law. If the Examiner finds it necessary to rely upon additional prior art, the Examiner can cite such references by imposing a new ground of rejection. *In re Hoch*, 428 F.2d 1341, 166 USPQ 406 (CCPA 1970).

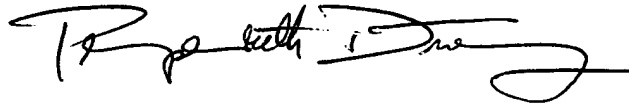
VI. CONCLUSION AND PRAYER FOR RELIEF

Appellants, therefore, request the Honorable Board to reverse each of the Examiner's rejections.

Respectfully Submitted,

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7/21/03
Date



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